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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,271	01/22/2001	Takashi Sako	AA33/VB	5065

27752 7590 10/25/2004

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EXAMINER	
WEBMAN, EDWARD J	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/744271	SAKO
Examiner	**Group Art Unit**
WEBMAN	1617

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 5/10/04.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

In the paper filed 5/10/04 applicants stipulate that the polymer structure in claims 1, 10 is representative of Carbopol 1382. Hence, the rejections in the action filed 7/2/01 remain relevant and are reinstated:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karlen et al. (US Patent No. 6,004,545) in view of Hitchen (US Patent No. 6,106,816), Kang et al. (WO 97/23194) and Rath et al. (US Patent No. 5,993,792).

Karlen et al. Teach hair cleansing compositions comprising copolymers of carboxylic acid such as Carbopol-1342 (column 6, line 62), an amphoteric conditioning polymer such as Merguat Plus 3300, (see column 7, line 55), aqueous carriers (water) (column 8, line 58) and silicon compounds (column 6, lines 11-13).

Karlen et al. do not teach a humectant, a viscosity modifier, a visible particle, an UV absorber, an optical brighter, an herbal extract and conditioning agents.

Hitchen teaches shampoo compositions comprising cationic polymeric conditionig agents such as Merquat 100 (column 4, line 37 and column 5, line 8). Copolymers of carboxylic acid such as Carbopol 1342 (abstract, column 3 line 63), aqueous carriers (water) and a silicone compound are also disclosed (abstract).

Kang et al. teach shampoo compostions comprising visible particles such as Unisphere (page 9, lines 4-6), humectant, viscosity modifiers such as thickeners (page

13, lines 20-21) for stabilizing and ensuring the homogeneous dispersion of a hair cleansing compositions (abstract). Copolymers of carboxylic acid such as Carbopol 1342, an aqueous carrier (water) (page 13, lines 5-6) and silicon compound are also disclosed (page 4, line 24).

Rath et al. teach shampoo and conditioner compositions comprising an optical brightener such as shine enhancers, herbal extracts and UV absorbers (column 2, lines 24-28, example 14). Viscosity modifiers such as a thickening composition are also disclosed (abstract).

It would have been prima facie obvious to a person of ordinary skill in the art at the time the invention was made to add Merquat 100 to the composition of Karlen et al. to achieve the beneficial effect of an additional conditioning agent in view of Hitchen and to further add visible particles, a humectant and viscosity modifiers of Kang et al. to the composition of Karlen et al. to achieve the beneficial effect of stabilizing and ensuring the homogeneous dispersion of a hair cleansing compositions..

As to other claimed "...further comprising..." ingredients, it would have been prima facie obvious to a person of ordinary skill in the art to further include such compounds in the obvious composition to achieve the extra beneficial effect of these additives in view of Rath et al.

See In re Kerkhoven 205 USPQ 1069. The combination of agents, each of which is known to be useful individually for the same purpose, into a single composition useful for the very same purpose, here, hair cleansing, is prima facie obvious. At least additive therapeutic effects would be reasonably expected.

As to the claimed weight percent, it is within the skill in the art to select optimal parameters such as ratios or weight percents of components in order to achieve a beneficial effect. See In re Boesch, 205 USPQ 215 (CCPA 19880). Therefore, the ratios or weight percents instantly claimed are not considered critical absent evidence showing unexpected and superior results.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 09/744,269 in view of Kang et al. (WO 97/23194).

This is a provisional obviousness-type double patenting rejection.

Claim 1 of this application claims a hair composition comprising copolymers of carboxylic acid.

Kang et al. teach a hair composition comprising copolymers of carboxylic acid and visible particles such as Unisphere to provide excellent conditioning and esthetic effects for the hair (abstract and page 9, lines 4-6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Unisphere to claim 1 to achieve the beneficial effect of providing excellent conditioning and esthetic effects for the hair. Thus, claim 1 of the copending Application No. 09/744,269 encompasses the obvious combination. This is a provisional obviousness-type double patenting rejection.

A new 112 rejection is added:

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 10 "R52 as defined above" is indefinite.

Does applicants intend the definition of R51?

No claims allowed.

Any inquiry concerning this communication should be directed to Edward J. Webman at telephone number 571-272-0633.

Webman/tgd

September 29, 2004

EDWARD J. WEBMAN
PRIMARY EXAMINER
GROUP 1500